

## REMARKS/ARGUMENTS

Entry of the foregoing amendment pursuant to the provisions of 37 CFR §116, and reconsideration of this application, in view of the foregoing amendment and the following remarks and arguments, are respectfully requested.

Claims 1-35 were originally presented for consideration in this application, with Claims 17-23 having previously been withdrawn from consideration. By the foregoing amendment, Claims 1-35 have been canceled without prejudice or disclaimer and replaced with new Claims 36-63. Accordingly, Claims 36-63 are now present in this application for consideration and allowance.

The previously pending apparatus Claims 1-16 and 24-35 were all finally rejected under 35 USC§101 and 35 USC§112 based on the Examiner's contention that each of these claims contained both apparatus and method limitations and was thus nonstatutory and indefinite. For example, he refused to give any patentable weight to the phrase "gas being injected from the main wellbore into the formation via the storage wellbore" in apparatus Claim 24, characterizing this phrase as a **method** limitation as opposed to a functional limitation associated with one of the recited apparatus elements in this claim.

In the foregoing amendment, these nonstatutory and indefiniteness rejections have been overcome by canceling all of the finally rejected apparatus Claims 1-16 and 24-35 and replacing them with respectively corresponding method Claims 36-63. All of the limitations in these claims are method limitations, thereby clearly overcoming the Examiner's previous characterization of various ones of applicant's claims as improperly containing a mixture of apparatus and method limitations.

For the Examiner's convenience, new independent method Claims 36 and 52 are reproduced below with certain portions thereof having been bolded to highlight the pure "method" character of these claims and their associated dependent claims.

\*\*\*\*\*

36. For use with a subterranean gas storage formation wherein gas is stored within pores of formation rock, a gas storage and production **method** comprising the **steps** of:

**extending** a production wellbore into the formation for withdrawing gas from the formation;

**extending** a production wellbore into the formation for withdrawing gas from the formation;

**causing** the production and storage wellbore to intersect at a wellbore junction; and

**injecting** gas into the formation through the storage wellbore.

52. A **method** of storing and producing gas, the method comprising the **steps** of:

**extending** a main wellbore from the earth's surface to a wellbore junction;

**extending** a storage wellbore from the main wellbore into a gas storage formation;

**extending** a production wellbore from the main wellbore into the formation;

**injecting** gas from the main wellbore into the formation via the storage wellbore; and

**withdrawning** gas from the formation into the main wellbore via the production wellbore.

This rewriting of applicant's previously submitted apparatus Claims 1-16 and 24-35 in method format is seen to clearly overcome the Examiner's 35 USC §101 and §112 rejections. It is thus respectfully requested that they be withdrawn. In his August 7, 2003 Final Office Action, the Examiner also stated that it was unclear to him how gas is being injected from the main wellbore into the formation via the storage wellbore **at the same time** the gas is being withdrawn from the formation into the main wellbore via production wellbore. However, none of applicant's claims require this simultaneous gas injection and withdrawal. For example, new Claim 52 recites both gas injection and withdrawing steps, but is silent on whether they are performed at the same time.

Turning now to the merits of applicant's claims, via independent Claims 36 and 52, each of applicant's Claims 36-63 specifies the **injection** of gas into a formation through a storage wellbore. Neither of the Scott and Pringle et al references currently being relied upon by the Examiner discloses or in any manner suggests this claimed **gas injection step**. It is thus respectfully submitted that all of applicant's method Claims 36-63 are patentably distinguishable over these references.

In view of the foregoing amendment, remarks and arguments, all of the claims currently pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of Claims 36-63 is therefore earnestly solicited.

It is noted that the foregoing amendment is clearly enterable under the provisions of 37 CFR §116 since the amendment (1) reduces the issues for appeal, (2) reduces the total number of claims pending in the application, and (3) does not raise any new issues since it merely sets forth applicant's claimed invention in method terminology instead of apparatus terminology.

The Examiner is hereby requested to telephone the undersigned attorney of record at 972/516-0030 if such would further or expedite the prosecution of the instant application.

Respectfully submitted,

KONNEKER & SMITH, P.C.



J. Richard Konneker  
Attorney for Applicant  
Registration No. 28,867

Dated: September 16, 2003

660 N. Central Expwy., #230

Plano, Texas 75074

972/516-0030

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450,

on September 16, 2003  
Charity Sait